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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,105	11/06/2001	Christopher Scott Brehm	18360/233830	9449
826	7590	12/19/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/013,105	Applicant(s) BREHM ET AL.	
	Examiner Igor Borissov	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 37-52 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19-36 and 53-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 1-18, 37-41 and 57-60, drawn to a method and apparatus for presorting mail into batches, classified in class 209, subclass 900.
- B. Claims 19-25, drawn to a method for articles handling, classified in class 414, subclass 334.
- C. Claims 26-36, drawn to a method and apparatus for distributing a rebate, classified in class 705, subclass 14.
- D. Claims 53-56, drawn to a method for shipping mail, classified in class 414, subclass 265.
- E. Claims 42-52, drawn to a method and system for monitoring sizes of batches, classified in class 209, subclass 659.

Inventions A, B, C, D and E are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention A has utility separate from that of inventions B, C, D and E such as presorting mail into batches; invention B has utility separate from that of inventions A, C, D and E, such as articles handling; invention C has utility separate from that of inventions A, B, D and E, such as distributing a rebate; invention D has utility separate from that of inventions A, B, C and E, such as shipping mail; and invention E has utility separate from that of inventions A, B, C and D, such as monitoring sizes of batches. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

During a telephone conversation with Scott Anderson, Esq., on December 6, 2005 a provisional election was made without traverse to prosecute the invention of A, Claims 1-18, 37-52 and 57-60. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of Claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 19-25, 26-36 and 53-56 are withdrawn from further consideration by the examiner, 37 FR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites the following limitation: "a plurality of senders of said mail pieces, each of said senders to fill a container with said mail pieces". The term

Art Unit: 3639

sender could be understood as a human being, which is not a statutory subject matter.

A claim directed to or including within its scope a **human being** will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of limited, but exclusive property right in a human being is prohibited by the Constitution. Accordingly, it is suggested that any claim directed to a non-plant multicellular organism which would include a human being within its scope include the limitation "non-human" to avoid this ground of rejection. The use of a negative limitation to define the metes and bounds of the claimed subject matter is a permissible form of expression, *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39-41 include the term "may", which expresses the potential capability not an actual method step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over Humes et al. (US 5,377,120) in view of Oh, Je H. (EP 0 575 109 A1).

Humes et al. (Humes) teaches an apparatus for processing mail pieces, comprising:

Independent Claims

Claim 1,

A plurality of senders of said mail pieces, each of said senders to provide a stack of said mail pieces (Fig. 1, items 1-4);

a holding facility for receiving said stacks of mails from said senders and gather said stacks into one or more hoppers (Figs. 2 and 3; items 44-45; C. 3, L. 61-62);

a pre-sorting business to receive said pools from said holding facilities and sort said mail pieces into a pre-sorted batch (Fig. 3; items 61 and 63; C. 5, L. 34-38).

Humes does not specifically teach that said stacks of mail pieces are received in containers at one or more holding facilities for gathering said containers into one or more pools.

Oh, Je H. (Oh) teaches a system for processing mail, wherein mail pieces received from senders accumulated in containers 34, said containers 34

Art Unit: 3639

are accumulated at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail pieces are received in containers wherein said containers 34 are accumulated at a holding facility 31 for further pre-sorting and delivery to a mail service, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53).

Claim 37,

Humes teaches said apparatus for processing mail pieces, comprising:

a plurality of senders of said mail pieces, each of said senders to provide a stack of said mail pieces (Fig. 1, items 1-4);

a transport business for receiving said stacks of mails from said senders and gather said stacks into one or more hoppers (Figs. 2 and 3; items 44-45; C. 3, L. 61-62);

a pre-sorting business to receive said pools from said holding facilities, sort said mail pieces into said pre-sorted batch, and tender said batch to a postal service (Fig. 3; items 61 and 63; C. 5, L. 34-38).

Humes does not specifically teach that said stacks of mail pieces are received in containers which are delivered via a transport business.

Oh, Je H. (Oh) teaches a system for processing mail, wherein mail pieces received from senders accumulated in containers 34 for further pre-sorting and delivery by a carrier to mail service (Fig. 1, item 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail

Art Unit: 3639

pieces are received in containers for delivery by a carrier, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53). Furthermore, cooperation disclosed between business entities in Humes and Oh indicates that said entities bound by an agreement.

Claim 57,

Humes teaches a method for processing mail pieces, comprising:

receiving one or more stacks of mail pieces (Fig. 1, items 1-4);

unpacking said stacks and sorting said mail pieces into a pre-sorted batch (Fig. 3; items 61 and 63; C. 5, L. 34-38).

tendering said pre-sorted batch to said postal service facility for mailing at an entry rate of postage (Fig. 3; items 61 and 63; C. 5, L. 34-38).

Humes does not specifically teach that said stacks of mail pieces are received in containers.

Oh, Je H. (Oh) teaches a system for processing mail, wherein mail pieces received from senders accumulated in containers 34 for further pre-sorting and delivery by a carrier to mail service (Fig. 1, item 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail pieces are received in containers for delivery by a carrier, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53). Furthermore, cooperation disclosed between business entities in Humes and Oh indicates that said entities bound by an agreement.

Dependent Claims

Claims 2-13, 15-18 and 39-41, same system as recited in Claims 1, 37 and 57. Furthermore, the additional limitations recited in Claims 2-13, 15-18 and 39-41 indicate the intended use of the system, not a structural element. Therefore, said additional limitations is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claims 2-13, 15-18 and 39-41 are disclosed in Humes and Oh as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claims 14 and 38. Humes and Oh teach all the limitations of Claims 14 and 38, except specifically teaching that said pre-sorting business comprises a plurality of pre-sorting businesses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes and Oh to include that said pre-sorting business comprises a plurality of pre-sorting businesses, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper*

Art Unit: 3639

Co. v. Bemis Co., 193 USPQ 8. The motivation of doing that would be to expand said business all over the country and abroad, thereby generating more revenue.

Claim 58. Said method further comprising the step of commingling said mail pieces (Kara; C. 3, L. 45).

Claim 59. Said method further comprising the step of preparing a document certifying to said postal service that said pre-sorted batch is qualified for mailing at an entry rate (generating a manifest, client package report or other documentation required by the post office to accompany each mailing) (Kara; C. 3, L. 50-52).

Claim 60. Said method wherein said postal service pays a rebate to said pre-sorting business, said rebate representing the difference between said entry rate and a program rate, said program rate representing the postage applied to each of said mail pieces by said sender (commingling the mailing pieces into bundles to be delivered at the lowest available postal rate indicates obtaining the rebate) (Kara; C. 3, L. 45-49).

Conclusion

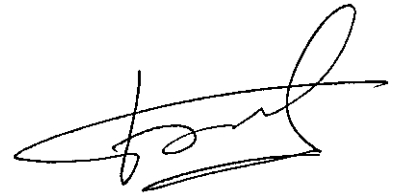
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a stylized, flowing script.

IB

12/12/2005